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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,729	02/18/2004	Yasumasa Morimoto	60866 (48882)	3394

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EDWARDS ANGELL PALMER & DODGE LLP  
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BOSTON, MA 02205

EXAMINER
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MORRISON, THOMAS A

ART UNIT	PAPER NUMBER
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3653

MAIL DATE	DELIVERY MODE
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10/10/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/782,729

Applicant(s)

MORIMOTO ET AL.

Examiner

Thomas A. Morrison

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 3, 4 and 7 is/are allowed.
- 6) ☒ Claim(s) 5, 6 and 8-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Applicant's amendment of 7/16/2007 has been entered.

#### ***Election/Restrictions***

2. Claims 1, 3-4 and 7 allowable. The restriction requirement directed to species I (i.e., Fig. 1), species II (i.e., Fig. 5), species III (i.e., Fig. 6), and species IV (i.e., Fig. 12), as set forth in the Office action mailed on March 30, 2005, has been reconsidered in view of the allowability of claims to the elected invention pursuant to MPEP § 821.04(a). **The restriction requirement is hereby withdrawn as to any claim that requires all the limitations of an allowable claim.** Claims 5-6 and 8-11, directed to non-elected species II, III and IV are no longer withdrawn from consideration because the claim(s) requires all the limitations of an allowable claim.

In view of the above noted withdrawal of the restriction requirement, applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 5-6 and 8-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 5, it is noted that this claim depends from claims 3 and 4, which ultimately depend from claim 1. Claim 1 recites "an outer casing member", "a stopper member", and "an arm member". After this, claim 5 recites "at least one of the outer casing member or members", "at least one of the stopper member or members", and "at least one of the arm member or members", respectively. It is unclear how many different outer casing members, stopper members and arm members are claimed in claim 5.

Regarding claim 6, it is noted that this claim depends from claims 3 and 4, which ultimately depend from claim 1. Claim 1 recites "an outer casing member", "a stopper member", and "an arm member". After this, claim 6 recites "at least one of the outer casing member or members", "at least one of the stopper member or members", and "at least one of the arm member or members", respectively. It is unclear how many different outer casing members, stopper members and arm members are claimed in claim 6.

Regarding claim 6, it is also unclear how many different guide components and how many different guide surfaces are claimed.

Regarding claim 8, it is noted that this claim depends from claim 7. Claim 7 recites "a pickup arm", "an engagement piece", "a stopper member", "a pickup roller", and "an outer casing member". After this, claim 8 recites "at least one of the pickup arm or arms", "at least one of the engagement piece or pieces", "at least one of the stopper member or members", "at least one of the pickup roller or rollers", and "at least one of the outer casing member or members", respectively. It is unclear how many different pickup arms, engagement pieces, stopper members, pickup rollers, and outer casing members are claimed in claim 8.

Regarding claim 8, it is also unclear how many different standby positions and how many different retaining members are claimed.

Regarding claim 9, it is noted that this claim depends from claim 8, which ultimately depends from claim 7. Claim 7 recites "an outer casing member" and "a pickup arm". After this, claim 9 recites "at least one of the outer casing member or members" and "at least one of the pickup arm or arms", respectively. It is unclear how many different outer casing members and how many different pickup arms are claimed in claim 9.

Regarding claim 9, it is also unclear how many different standby positions and how many different retaining members are claimed.

Regarding claim 10, it is noted that this claim depends from claim 8, which ultimately depends from claim 7. Claim 7 recites "a pickup roller" and "a pickup arm". After this, claim 10 recites "at least one pickup roller or rollers" and "at least one pickup

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arm", respectively. It is unclear how many different pickup rollers and how many different pickup arms are claimed in claim 10.

Regarding claim 10, it is also unclear how many different retaining members, pivot projections, and pivot constraining rods are claimed.

Regarding claim 11, it is noted that this claim depends from claim 8, which ultimately depends from claim 7. Claim 7 recites "a pickup arm" and "an outer casing member". After this, claim 11 recites "at least one of the pickup arm or arms" and "at least one of the outer casing member or members", respectively. It is unclear how many different pickup arms and how many different outer casing members are claimed in claim 11.

Regarding claim 11, it is also unclear how many different standby positions are claimed.

#### ***Allowable Subject Matter***

4. Claims 1, 3-4 and 7 are allowed. Claims 5-6 and 8-11 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Morrison whose telephone number is (571) 272-7221. The examiner can normally be reached on M-F, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey can be reached on (571) 272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

10/5/2007



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